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In the United States Patent and Trademark Office

In re the Application of:

Janani Janakiraman)

Serial Number: 09/915,838)

Group: 3622

Docket Number: AUS920010497US1)

Examiner: John W. Van Bramer

Filed on: 07/26/2001)

For: "Dynamic Composite)

Advertisements for Distribution)

via Computer Networks")

APPEAL BRIEF

Real Party in Interest per 37 CFR §41.37(c)(1)(i)

The subject patent application is owned by International Business Machines Corporation of Armonk, NY.

Related Appeals and Interferences per 37 CFR §41.37(c)(1)(ii)

None.

Status of Claims per 37 CFR §41.37(c)(1)(iii)

Claims 1 - 29 are finally rejected. The rejections of Claims 1 - 29 are appealed.

Status of Amendments after Final Rejections per 37 CFR §41.37(c)(1)(iv)

No amendments to the claims have been submitted or entered after final rejections.

Summary of the Claimed Subject Matter per 37 CFR §41.37(c)(1)(v)

Appellants have invention a process and mechanism which tailors electronic advertisement messages ("ads"), such as Internet ads, to include images of human models, where the human models are selected based on user characteristics such as age, gender, ethnicity, locale, etc. In general, Appellants' claims stipulate that a "depiction" of a "human model" is selected from a database of human model depictions based on demographic characteristics, then a composite advertisement is produced by merging the selected human model image with a background or other images of products, company logos, etc., and finally the composite ad is "provided for consumption" to a user, such as by display on a web browser screen.

More specifically, independent Claim 1 sets forth a method for dynamically generating targeted electronic advertisements including the steps of:

- (a) providing two or more data object repositories (*paras. [0031] and [0045]; fig. 3 #31 and #32; fig. 4a; fig. 4b*), said data object repositories containing a plurality of data objects indexed to target audience characteristics, at least one of said repositories containing depictions of a plurality of human models indexed by demographic characteristics of the human models (*paras. [0031] and [0045]; fig. 3 #31; fig. 4a*);
- (b) selecting (*para. [0037]; fig. 3 #35*) two or more data objects from said data object repositories based upon a given set of instant user characteristics (*para. [0037]; fig. 3 #37*), at least one of said selected data objects comprising a depiction of a human model (*paras. [0031] and [0045]; fig. 3 #31; fig. 4a*) having matching demographic characteristics;
- (c) producing (*para. [0037]; fig. 3 #39*) a composite advertisement object (*para. [0047]; fig. 5 #301*) by combining said selected data objects to render a single advertisement data object; and
- (d) providing for consumption said composite advertisement object to said instant user (*para. [0047]; fig. 3 #39; fig. 5 #20 and #22*).

Likewise, independent Claim 11 sets forth an article of manufacture as a computer readable medium encoded with software, where the software is specifically configured to perform the steps of:

- (a) provide two or more data object repositories (*paras. [0031] and [0045]; fig. 3 #31 and #32; fig. 4a; fig. 4b*), said data object repositories containing a plurality of data objects indexed to target audience characteristics, at least one of said repositories containing depictions of a plurality of human models indexed by demographic characteristics of the human models (*paras. [0031] and [0045]; fig. 3 #31; fig. 4a*);
- (b) select (*para. [0037]; fig. 3 #35*) two or more data objects from said data object repositories based upon a given set of instant user characteristics (*para. [0037]; fig. 3 #37*), at least one of said selected data objects comprising a depiction of a human model (*paras. [0031] and [0045]; fig. 3 #31; fig. 4a*) having matching demographic characteristics;
- (c) produce (*para. [0037]; fig. 3 #39*) a composite advertisement object (*para. [0047]; fig. 5 #301*) by combining said selected data objects to render a single advertisement data object; and
- (d) provide for consumption said composite advertisement object to said instant user (*para. [0047]; fig. 3 #39; fig. 5 #20 and #22*).

A system according to the invention is set forth in independent Claim 21, including:

- (a) two or more data object repositories (*paras. [0031] and [0045]; fig. 3 #31 and #32; fig. 4a; fig. 4b*), said data object repositories containing a plurality of data objects indexed to target audience characteristics, at least one of said repositories containing depictions of a plurality of human models indexed by demographic characteristics of the human models (*paras. [0031] and [0045]; fig. 3 #31; fig. 4a*);
- (b) a data object selector for selecting (*para. [0037]; fig. 3 #35*) two or more data objects from said data object repositories based upon a given set of instant user characteristics (*para. [0037]; fig. 3 #37*), at least one of said selected data objects comprising a depiction of a human model (*paras. [0031] and [0045]; fig. 3 #31; fig. 4a*) having matching demographic characteristics;
- (c) a composite advertisement object renderer for combining said selected data objects to render a single advertisement data object (*para. [0037]; fig. 3 #39*); and

- (d) a rendered composite advertisement object provided for consumption to said instant user (*para. [0047]; fig. 3 #39; fig. 5 #20 and #22*).

Grounds for Rejection For Which Review is Sought per 37 CFR §41.37(c)(1)(vi)

Appellants request review by the Board is requested of the following final actions by the Examiner:

- (1) improper rejections of claims 21 - 29 under 35 U.S.C. §112;
- (2) improper rejections of claims 21 - 29 under 35 U.S.C. §101; and
- (3) erroneous rejections of claims 1 - 29 under 35 U.S.C. §102(e) over U.S. Patent 6,327,574 to Kramer, *et al.* (hereinafter "Kramer").

Arguments per 37 CFR §41.37(c)(1)(vii)**Rejections of Claims 21 - 29 under 35 U.S.C. §112**

In the first Office Action, the examiner rejected claims 21 - 29 under 35 U.S.C. §112, second paragraph, reasoning that the system claims only set forth various data and data objects but without any express, implied, or inherent structure or functions of the system. Specifically, the examiner stated that he was unable to determine the "type of system, which the application considers as his/her invention".

Please note that Claim 21 specifically recites the functions and structural relationship of four (4) system components:

- (1) Two data object repositories, having certain recited contents (e.g. at least one of which has the depictions of human models);
- (2) The "data object selector" operates on the input data object repositories, quoting the second element of Claim 21 (emphasis added by Appellants):

". . . a data object selector for selecting two or more data objects from said data object repositories . . . "

Clearly, this element of the claim is functionally and structurally related to the first element (e.g. the repositories), and clearly it is performing a function (e.g. selecting on a recited basis).

- (3) The "renderer" then operates on the results of the of the "selector" by merging or combining the selected objects into a single composite ad (emphasis added by Appellants):

" . . . a composite advertisement object renderer for combining said
selected data objects to render a single advertisement data object . . . "

Clearly, the "renderer" is structurally related to the "selector" by operating on the "said selected data objects", and clearly the "renderer" is recited as having a specific function (e.g. creating a single advertisement data object).

- (4) The final structural element recited in the claim is the actual "rendered composite advertisement" itself, which is related to the "renderer", and which is "consumable" by the user (e.g. tangible being displayed, played, etc.).

However, in the rationale for the final rejections, the examiner has suggested that the existence of the word "for" throughout the claim leads to missing structural and functional requirements.

Appellants respectfully submit that there is no legal basis for this holding, and that phrases reciting "for <some function> on <some element>" enjoy long and historical understanding as descriptive phrases which can recite both function and relationship to other claim elements. Given that the claims closely follow the examples provided in the disclosure, it is unlikely that one of ordinary skill in the art would be confused by such language. Additionally, as shown in the foregoing paragraphs, several elements, their functions, and their structural relationships are clearly recited in the claims.

Appellants request reversal of the examiner's rejections, and allowance of claims 21 - 29 for these reasons.

Rejections of claims 21 - 29 under 35 U.S.C. §101

In the first Office Action, the examiner rejected claims 21 - 29 under 35 U.S.C. §101, for being directed towards non-statutory matter, specifically reasoning that only data and data objects are claimed, without structure or function. The examiner also reasoned that no tangible output was produced.

Regarding claim recitation of elements, structure and function, please refer to the foregoing arguments with reference to the rejections under §112, second paragraph. In these arguments, it is established that the following structures, functions, and interrelationships are

claimed.

Regarding claim recitation of a tangible result, Appellants have claimed a "rendered composite advertisement" for consumption by the user. In paragraph [0023], Appellants have specifically stated that "consumption" by a user includes viewing and/or hearing by the user. Since hearing or viewing by a user necessarily implies that the thing seen or heard is "tangible", then Appellants have recited a tangible output or result.

In summary, the foregoing paragraphs establish structural elements, their functions and relationships to each other, and a tangible result or output as follows (claim language paraphrased):

Structural Element	Function of Element	Relationship to Other Structural Elements
2 data object repositories	stores depictions of human models	accessed by data object selector
data object selector	selectively retrieves a depiction of a human model according to user characteristics and a second data object (e.g. the background ad)	accesses the data object repositories
renderer	creates a composite ad by combining the selected human model depiction and the second data object (e.g. overlays the human model image over the background ad)	uses the result or output of the data object selector
composite ad	this is a displayable, viewable, audible, etc., composite ad (e.g. tangible output)	output or created by the renderer

However, after Appellants pointed out these facts to the examiner, the examiner issued final rejections on the same rationale.

For these reasons, Appellants respectfully submit that the rejections of claims 21 - 29 under 35 U.S.C. §101 is improper and erroneous. Reversal of these rejections is requested.

Rejections of Claims 1 - 29 under 35 U.S.C. §102(e) over Kramer

In the first Office Action, claims 1 - 29 were rejected under 35 U.S.C. §102(e) over Kramer, specifically noting passages of Kramer's disclosure which presumably teach all of Appellants' claim elements, steps, and limitations.

Appellants responded by pointing out that their invention disclosure sets forth selection of images or movies which feature "human models" that correspond to the demographic characteristic of the viewer of the produced advertisement. Applicants have provided examples of what is meant by the term "human model" throughout their disclosure, including an example image of a family having young children selected because the viewer is determined to be a member of such a family. This enhances the advertising message by providing images with which the viewer can identify. As such, by "human model", applicants mean the common definition meaning a human person acting as a spokesperson or representative of a product or service, as disclosed in the specification of the present patent application.

Appellants more specifically called the examiner's attention to the fact that Kramer's "consumer models", however, are not images of spokespersons or human representatives of services or products, but instead are *mathematical functions* regarding characteristics of a user or consumer, as explicitly defined by Kramer and consistently used throughout Kramer's disclosure:

A "**model**" is a **mathematical function** which attempts to predict the appeal to the consumer of future transactions based on interests and behavior derived from past transactions, and consists of an **attribute vector** and a set of **mapping functions**;

An "**attribute vector**" is a vector of **data values** such that each element of the vector represents an attribute of the consumer;

A "**mapping function**" is a **mathematical function** that is used to convert between factual information (such as data regarding a transaction or whether an individual is pregnant) and elements of an attribute vector;

(Col. 4, lines 48 - 56, emphasis added by Applicants)

As such, Appellants showed that Kramer's "consumer model" mathematical functions are not the same as Applicants' claimed "human model" images. To hold such equivalency would be to improperly import Applicants definitions and disclosure into the cited art.

Appellants also showed that Kramer discloses "illuminations" (col. 4 lines 64 - 67) as pieces of targeted content, plus matching criteria to determine whether or not a particular illumination correlates to a user's consumer model. Kramer is silent regarding selecting images of human models which match the user's ethnic, economic, age, familial, or other demographic characteristics, but instead discloses selection of company logos, hyperlinks, video advertisements for a product, images of products, coupons, etc.:

Illumination is the process of annotating or replacing sections of documents or other media with (possibly) related multimedia content. Typically the new content expands on the information in the original content and/or provides a more interesting presentation of the information. As examples, the name of a company or product might be illuminated with a **graphical logo** or a **hyperlink** to a home page, a **video presentation**, or a presentation for some **completely different product or company**; an input field in a form may be illuminated by replacing it with the information being requested; an empty spot in a video broadcast may be replaced with **a commercial**. The choice of illumination for a given section may depend on the content of the section, the overall content of the document, the choices made for illuminating other sections, the context such as time and location in which the content is being viewed and attributes or profile of the viewer. The illumination may occur at any point in the production and delivery process for the media. The degree of flexibility and context dependence in the choice of illumination will depend on how early or late in the process the illumination occurs and how much information about the context is available to the illuminator. This flexibility ranges from static content (i.e. content that is the same for all viewers and contexts) to viewer-specific content (i.e. content which may vary for each viewer).
(Col. 6, lines 22 - 46, emphasis added by Applicants).

Appellants established that the paragraphs following this paragraph in Kramer are replete with examples of such replacements, but are silent as to selecting images or videos of human spokespersons (e.g. appellants' "human models") on the basis that the Appellants have disclosed and claimed.

Appellants' response to the first Office Action, therefore, included amendment to the independent claims 1, 11, and 21, to specify "human model" images or videos.

In the second Office Action, however, the examiner maintained the rationale for these rejections, making the rejections Final. And, the examiner responded that:

(a) the examiner was unable to find where in Appellants' disclosure a limiting definition of a "human model" is made, and

(b) the examiner pointed out that Kramer shows an image of person in Figure 18, thus Kramer shows "human models" within Appellants definition.

Regarding Appellants disclosure and definition of "human model", it is inherent that humans are not mathematical functions. Models of human behavior are not the same as depictions (images, videos, recordings) of human models, of course.

But, Appellants have shown examples of "human models" in Figure 4a, and have described "human models" as "human model or spokesperson" (para. [0013]), model data objects such as graphic images, video clips, and sound clips (para. [0031]), models as human models or alternatively cartoon characters (para. [0031]), operation on a "model image" (para. [0037]), and an example image of a family as human models (para. [0045]).

Moreover, recent case law has reinforced the requirement to read a claim term "not only in the context of the particular claims in which the disputed term appears, but in the context of the entire patent, including the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (en banc). This claim interpretation methodology is, therefore, centered on using the specification as the primary source of defining claim terms, where extrinsic sources and ordinary meanings are utilized in the absence of any definitions in the disclosure.

The examiner has not shown where in the Appellants' disclosure it could be gleaned that the claimed "human model depictions" are interpretable as mathematical functions, nor has the examiner provided any extrinsic evidence of this term having any alternate definition to that provided in the Appellants' disclosure.

With respect to Kramer's disclosure in their Figure 18, it should be noted that the image of the "Animorphs, The Solution" book cover depicts a human model's transmutation into a mouse. This analysis, however, ignores the limitation of Appellants' claims with respect to

selection of the human model image based upon the user's characteristics, and producing a combined image to show to the user. First, Kramer discloses that the Animorph book is selected because the user is known to be a child, and the book is of the type and character which interests children. However, an image of a child is not present in the Animorph book cover. What is present on the cover of the book is an *adult* human, a mouse, and some mutation stages therebetween. Further, Kramer is silent as to merging two images to produce the final book cover image. Instead, unless Kramer is somehow suggesting a print-on-demand process where the child user's image is dynamically produced on the cover of a book to be sold, it must be assumed that this is a conventional book cover which has images statically produced on it. Animorph books are well known, and there is no evidence provided by the examiner that they are anything but conventional books with conventional, pre-printed covers.

As such, the *book cover human image* of Figure 18 is not selected according to the user's characteristics, rather the *book* is selected according to the user's characteristics. Kramer fails to teach *selecting a human model image*, nor does Kramer's Figure 18 teach *producing a composite image* using a selected image of human model and another image.

For these reasons, Appellants respectfully submit that the rejections of claims 1 - 29 over Kramer are erroneous and improper. Thus, Appellants request reversal of these rejections.

Conclusion

In summary, Appellants have amended certain claims to clarify and specify elements, steps, and limitations not taught by the cited art. Further, Appellants have established and demonstrated that the claims and disclosure meet the requirements of 35 U.S.C. §101 and §112, second paragraph.

For these reasons, Appellants request allowance of claims 1 - 29.

Respectfully Submitted,

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Claims Appendix
per 37 CFR §41.37(c)(1)(viii)

Clean Form of Amended Claims

1. (previously presented) A method for dynamically generating targeted electronic advertisements comprising the steps of:

providing two or more data object repositories, said data object repositories containing a plurality of data objects indexed to target audience characteristics, at least one of said repositories containing depictions of a plurality of human models indexed by demographic characteristics of the human models;

selecting two or more data objects from said data object repositories based upon a given set of instant user characteristics, at least one of said selected data objects comprising a depiction of a human model having matching demographic characteristics;

producing a composite advertisement object by combining said selected data objects to render a single advertisement data object; and

providing for consumption said composite advertisement object to said instant user.

2. (previously presented) The method as set forth in Claim 1 wherein said step of selecting further comprises pseudo-randomly selecting a data object.

3. (previously presented) The method as set forth in Claim 1 wherein said human model depictions comprise depictions selected from the group of a still graphic image repository, a video clip, and an audio clip.

4. (original) The method as set forth in Claim 1 wherein said step of providing two or more data object repositories comprises providing an advertising message repository.

5. (original) The method as set forth in Claim 4 wherein said step of providing an advertising message repository is selected from the group consisting of providing a still graphic image repository, providing a video clip repository, providing a web page repository, and providing an audio clip repository.

6. (original) The method as set forth in Claim 1 wherein said step of selecting two or more data objects from said data object repositories based upon a given set of instant user characteristics comprises selecting data objects based upon instant user demographic factors.

7. (original) The method as set forth in Claim 1 wherein said step of selecting two or more data objects from said data object repositories based upon a given set of instant user characteristics comprises selecting data objects based upon historical advertising effectiveness trend data.

8. (original) The method as set forth in Claim 1 wherein said step of producing a composite advertisement object is selected from the group consisting of overlaying one still graphic image data object over another, merging a video clip with an audio clip, and merging a plurality of video clips.

9. (original) The method as set forth in Claim 1 wherein said step of providing for consumption a composite advertisement object to an instant user is selected from the group consisting of transmitting said composite advertisement object over a computer network, displaying said composite advertisement, and playing said composite advertisement.

10. (original) The method as set forth in Claim 7 further comprising a step of updating said historical advertising effectiveness trend data according to subsequent instant user selection of options related to said composite advertisement object.

11. (previously presented) A computer readable medium encoded with software for dynamically generating targeted electronic advertisements comprising, said software when executed causing a computer to perform the steps of:

provide two or more data object repositories, said data object repositories containing a plurality of data objects indexed to target audience characteristics, at least one of said repositories containing depictions of a plurality of human models indexed by demographic characteristics of the human models;

select two or more data objects from said data object repositories based upon a given set of instant user characteristics, at least one of said selected data objects comprising a depiction of a human model having matching demographic characteristics;

produce a composite advertisement object by combining said selected data objects to render a single advertisement data object; and

provide for consumption said composite advertisement object to said instant user.

12. (previously presented) The computer readable medium as set forth in Claim 11 wherein said software for selecting further comprises pseudo-randomly selecting a data object.

13. (previously presented) The computer readable medium as set forth in Claim 11 wherein said software for providing a human model repository is adapted to provide repository objects selected from the group consisting of a graphic image, a video clip, and an audio clip.

14. (original) The computer readable medium as set forth in Claim 11 wherein said software for providing two or more data object repositories comprises providing an advertising message repository.

15. (original) The computer readable medium as set forth in Claim 14 wherein said software for providing an advertising message repository is adapted to provide repository objects selected from the group consisting of a still graphic image, a video clip, a web page, and an audio clip.

16. (original) The computer readable medium as set forth in Claim 11 wherein said software for selecting two or more data objects comprises software for selecting data objects based upon instant user demographic factors.

17. (original) The computer readable medium as set forth in Claim 11 wherein said software for selecting two or more data objects comprises software for selecting data objects based upon historical advertising effectiveness trend data.

18. (original) The computer readable medium as set forth in Claim 11 wherein said software for producing a composite advertisement object is adapted to perform a composite advertisement selected from the group consisting of a still graphic image overlaid on another still graphic image, a video clip merged with an audio clip, and a plurality of video clips merged together.

19. (original) The computer readable medium as set forth in Claim 11 wherein said software for providing for consumption a composite advertisement object to an instant user is adapted to use a method selected from the group consisting of transmitting said composite advertisement object over a computer network, displaying said composite advertisement, and playing said composite advertisement.

20. (original) The computer readable medium as set forth in Claim 17 further comprising software for updating said historical advertising effectiveness trend data according to subsequent instant user selection of options related to said composite advertisement object.

21. (previously presented) A system for dynamically generating targeted electronic advertisements comprising:

two or more data object repositories, said data object repositories containing a plurality of data objects indexed to target audience characteristics, at least one of said repositories containing depictions of a plurality of human models indexed by demographic characteristics of the human models;

a data object selector for selecting two or more data objects from said data object repositories based upon a given set of instant user characteristics, at least one of said selected data objects comprising a depiction of a human model having matching demographic characteristics;

a composite advertisement object renderer for combining said selected data objects to render a single advertisement data object; and

a rendered composite advertisement object provided for consumption to said instant user.

22. (previously presented) The system as set forth in Claim 21 wherein said data object selector is further configured to pseudo-randomly select a data object.

23. (previously presented) The system as set forth in Claim 21 wherein said human model depictions are selected from the group consisting of still graphic images, video clips, and audio clips.

24. (original) The system as set forth in Claim 21 wherein said data object repositories comprise an advertising message repository.

25. (original) The system as set forth in Claim 24 wherein said advertising message repository includes a data object selected from the group consisting of still graphic images, video clips, web pages, and audio clips.

26. (original) The system as set forth in Claim 21 wherein said data objects selector is adapted to select data objects from said data object repositories based upon instant user demographic factors.

27. (original) The system as set forth in Claim 21 wherein said data objects selector is adapted to select data objects based upon historical advertising effectiveness trend data.

28. (original) The system as set forth in Claim 21 wherein said composite advertisement object renderer is adapted to produce a composite advertisement object selected from the group consisting of two overlaid still graphic images, a merged video clip and audio clip, and a merged plurality of video clips.

29. (original) The system as set forth in Claim 21 further comprising a historical data updater for updating said historical advertising effectiveness trend data according to subsequent instant user selection of options related to said composite advertisement object.

Evidence Appendix
per 37 CFR §41.37(c)(1)(ix)

No evidence has been submitted by applicant or examiner pursuant to 37 CFR §§1.130, 1.131, or 1.132.

Related Proceedings Appendix
per 37 CFR §41.37(c)(1)(x)

No decisions have been rendered by a court or the Board in the related proceedings as identified under 37 CFR §41.37(c)(1)(ii).